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10/731,159	12/08/2003	Richard J. Schneider	AC053 (26668-58)	5096

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EXAMINER	
LEIVA, FRANK M	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

Office Action Summary	Application No.	Applicant(s)	
	10/731,159	SCHNEIDER ET AL.	
	Examiner	Art Unit	
	FRANK M. LEIVA	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-32 and 49-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-32 and 49-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. The examiner acknowledges amendments to claims 1 and 49 in applicant's submission filed 29 October 2008.

Response to Arguments

2. Applicant's arguments filed 29 October 2008 have been fully considered but they are not persuasive. Reasons as follows;

3. Regarding the argument directed to the 35 U.S.C. § 112 1st paragraph is not persuasive; the specification only mentions allowing the unenrolled player to enroll, or awarding a player for enrolling if he/she chooses, not to "convert to enrolled", the difference lies in the recorded previous play being turned into enrolled player recorded play, a conversion implies renaming the current history under the players name which was before anonymous. This is considered new matter.

4. Regarding the arguments directed to the 35 U.S.C. § 103(a) are not persuasive because the applicant in giving more meaning to the claim interpretation than is specified in applicant's specification ¶ [0030], "Alternatively, the casino or operator can configure the promotion server 68 to award promotions not related to coin-in, for example, incentives for enrolling in player tracking programs", so for instance in claims 1 and 49 the incentive the player would have earned had he enrolled at the beginning of play is simply the enrollment incentive everybody gets when enrolling for the first time regardless of the amount of coin played since he or she have been playing so far, and covered by Acres as applied bellow.

5. The rest of the arguments are directed to claims 1 and 49 as allowable with the new amendments, and are moot in view of the new rejections.

Claim Rejections - 35 USC § 112

6. **Claim 55** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material which is not supported by the original disclosure is as follows; "converting the unenrolled player account into an enrolled player account", the word converting having not been used in the specification imply a much larger meaning to the disclosed invention. By converting one of ordinary skill in the art would interpret to include the players already built history and play in the new account, which in no means is expressed in the disclosed invention. The present application simply gives the player an opportunity to enroll after a trigger event.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 3-10, 23-24 and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al (US 2004/0002386 A1) in view of Acres (US 6,371,852 B1).

9. Regarding the analogous combination; **Wolfe** discloses a wireless casino player tracking system that tracks play on the floor of players that have not been registered into the system; and **Acres** discloses a method for adding incentive to enroll into a player tracking account system.

10. **Regarding claim 1;** Wolfe discloses a method of registering an unenrolled player in a player tracking system, comprising:

permitting the unenrolled player to play a gaming device using an unenrolled player account, (¶ [0118]).

detecting a triggering event, (¶ [0117]), Qualifying for "hot player" status.

notifying the unenrolled player after the occurrence of the triggering event; and allowing the unenrolled player to enroll in the player tracking system in response to the notification, (¶ [0118-0119]);

Wolfe fails to disclose enrollment incentives whereas Acres discloses the very well-known marketing tool of enrollment incentives by awarding the unenrolled player enrollment incentives for enrolling, (abstract, col. 1:49-51 and col. 7:24-26).

presenting the unenrolled player with enrollment incentives that the unenrolled player would have earned if enrolled in the player tracking system, (col. 7:24-30);

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine the player tracking enrollment incentive of Acres into the unenrolled player tracking system of Wolfe to predictably entice the player into forwarding his/hers information and participate in the card system. Also it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to promote such an expensive feature by letting the players know that there is an advantage to playing while carded, as shown in Acres (col. 8:4-8), where players that are enrolled would get a higher amount of bonus award than those not in the system. This goes without saying that all promotional aspects in a casino are well advertised to maximize effect; it serves no purpose to award bonuses if people are not aware of their existence. So presenting, showing, or warning that the player may win a larger amount if enrolled in the system is obvious and part of the normal operation of any marketing tool.

11. **Regarding claim 3;** Wolfe discloses wherein the detecting a triggering event comprises detecting, by the player tracking system, that a triggering event has been detected and prompting a casino employee present at the gaming device to contact the unenrolled player, (¶ [0118]).

12. **Regarding claim 4;** Wolfe discloses wherein a plurality of unenrolled players play a plurality of gaming devices, (¶ [0117]), wherein carded and uncarded players can play.

13. **Regarding claim 5;** Wolfe discloses wherein the plurality of gaming devices are networked together, (¶ [0117]), the information is accumulated by the tracking system.

14. **Regarding claim 6;** Wolfe discloses wherein the triggering event corresponds to an unenrolled player among the plurality of players having a highest level of player rating, (¶ [0117]).

15. **Regarding claim 7-8;** Wolfe discloses wherein the triggering event is a random occurrence, (¶ [0018]), randomly occurring Jackpots events or random promotions such as "Hot Seat".

16. **Regarding claim 9;** Wolfe discloses wherein the triggering event is a predetermined occurrence, (¶ [0172]).

17. **Regarding claim 10;** Wolfe discloses wherein notifying the unenrolled player comprises soliciting the unenrolled player to enroll in the player tracking system, (¶ [0119]).

18. **Regarding claim 23;** Wolfe discloses wherein the unenrolled player is allowed to enroll with the assistance of casino personnel, (¶ [0119]).

19. **Regarding claim 24;** Wolfe discloses wherein casino personnel approach the unenrolled player after the occurrence of the triggering event.

20. **Regarding claims 53-54;** Wolfe discloses wherein if the unenrolled player chooses not to enroll in the player tracking system, said method further comprises:

tracking continued play of the unenrolled player; notifying the unenrolled player after an occurrence of a subsequent triggering event, (¶ [0119 and 0171]), wherein if the player has the choice to apply for the players card but if refuses, simply returns to be an uncarded player whose play is tracked on the floor and if he/she becomes a hot player again (trigger event), a hostess will be assigned to communicate or interact with the player. Wolfe fails to disclose sign up incentives, but Acres discloses the well-known methods of sign up award incentives and multiple comps available to entice the players and offering alternative enrollment incentives for enrolling based on the continued play; and further comprising adjusting a frequency of notifications to the unenrolled player during play, (col. 1:49-51 and col. 7:24-26).

21. **Regarding claim 55**; Wolfe and Acres disclose all the limitations recited in claim 1 from which claim 55 depends on, although Wolfe and Acres are silent about the converting unenrolled play into enrolled play, it is well-known to casino operators to track players at table games and approach them for rating (tracking), Pitt bosses will commonly track a player and rate them without the players knowledge and when the Pitt boss decides, he approaches the player and offers to initiate them in the system or if the player is already enrolled, will add the already played rating into the players account. It is obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate all the known techniques of casino gaming to the casino player tracking systems of Wolfe and Acres.

22. **Claims 11- 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe and Acres as applied to claim 1 above and in further view of Walker et al. (US 2004/0127284 A1), hereinafter "Walker '284".**

23. **Regarding claims 11-16;** Wolfe and Acres discloses all the limitation of claim 1 from which claims 11-16 depend on; and Walker '284 discloses: wherein notifying the unenrolled player comprises visually notifying the unenrolled player; wherein notifying the unenrolled player comprises notifying the unenrolled player through a display

associated with the gaming device; wherein notifying the unenrolled player comprises notifying the unenrolled player through an overhead sign; wherein the aural notification is emitted from the gaming device; wherein the aural notification is emitted from a speaker remote to the gaming device, (fig. 8:802, ¶[0662-0689]), wherein fig. 8 shows a reminder message to the player to register for the player tracking system and the rest shows all forms used by walker to effectively communicate to the players according to the urgency of the message.

24. **Regarding claims 11-16;** It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of player messaging of Walker '284 in Wolfe's invention to further help the player's in the busy casino floor. It is obvious that Wolfe's system works better if the player is enrolled in the player tracking system and adding well-known messages to players that are not enrolled is a predictable use of the equipment already at hand.

25. **Claims 17-22 and 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe and Acres as applied to claim 1 above and in further view of Benoy.**

26. Regarding the analogous combination; Benoy invention discloses the many facets of a player tracking systems as the system of Wolfe an Acres and is expressive on the details of self enrollment.

27. **Regarding claim 17-22;** Wolfe and Acres discloses all the limitation of claim 1 from which claims 17-22 depend on; and Benoy discloses wherein the unenrolled player is allowed to self enroll; wherein the unenrolled player is allowed to enroll through a terminal on the casino floor; wherein the terminal is unattended; wherein the unenrolled player is allowed to enroll at the gaming device; wherein the unenrolled player is allowed to enroll through a keypad associated with the gaming device; wherein the unenrolled player is allowed to enroll through a display associated with the gaming

device, (col. 6:16-32). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine Benoy with Wolfe and Acres, since all three are inventions related to player tracking systems and marketing schemes to attract players. The self enrollment system of Benoy would be easy to implement in any Casino Kiosk machine and obvious to try by any casino establishment that wishes to reduce lines at the registration booths or reduce staff.

28. **Regarding claim 25;** Wolfe and Acres discloses all the limitation of claim 1 from which claim 25 depend on; and Benoy discloses applying a credit to the newly enrolled player's account following enrollment, (col. 6:63-64, 7:30-31). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine Benoy with Wolfe and Acres, since all three are inventions related to player tracking systems and marketing schemes to attract players. Allowing to add credits to the new account is the purpose of creating the account in the first place, and obvious to do (try).

29. **Regarding claims 26-32;** Wolfe and Acres discloses all the limitation of claim 1 from which claims 26-32 depend on; and Benoy discloses wherein the unenrolled player is permitted to play the gaming device using a temporary account; wherein credit is applied to the temporary account; wherein the unenrolled player is permitted access to the credit following enrollment; wherein the credit is payable immediately; wherein the credit is payable on a future visit; wherein the credit is payable incrementally; wherein the temporary account is associated with a player identifier, (col. 18:29-59). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine Benoy with Wolfe and Acres, since all three are inventions related to player tracking systems and marketing schemes to attract players. The temporary account of Benoy is necessary for a cashless system, yet it would be obvious to try it with Wolfe and Acres for players that wish to remain anonymous.

30. Claims 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoy et al. (US 6,896,618 B2), in view of Acres (US 6,371,852 B1).

31. **Regarding claim 49;** Benoy discloses a player tracking system for uncarded players, comprising: a host computer; a network interconnecting gaming devices to the host computer; means for tracking uncarded play by uncarded players having uncarded player accounts; a memory for storing the tracked uncarded play; means for detecting the occurrence of a triggering event; and means for notifying the uncarded players after the occurrence of the triggering event, (col. 2:25-36). Benoy is silent to enrollment incentives, whereas Acres discloses means for awarding enrollment incentives for enrolling in the player tracking system, (abstract, col. 1:49-51 and col. 7:24-26), presenting the unenrolled player with enrollment incentives that the unenrolled player would have earned if enrolled in the player tracking system, (col. 7:24-30). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine the player tracking enrollment incentive of Acres into the player tracking system of Benoy to predictably entice the player into giving his/hers information and participating in the player tracking card system. Also it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to promote such an expensive feature by letting the players know that there is an advantage to playing while carded, as shown in Acres (col. 8:4-8), where players that are enrolled would get a higher amount of bonus award than those not in the system. This goes without saying that all promotional aspects in a casino are well advertised to maximize effect; it serves no purpose to award bonuses if people are not aware of their existence. So presenting, showing, or warning that the player may win a larger amount if enrolled in the system is obvious and part of the normal operation of any marketing tool.

32. **Regarding claims 50-52;** Benoy and Acres discloses all the limitation of claim 49 from which claims 50-52 depend on and Benoy also discloses means for enrolling the uncarded players in a player tracking system; means for awarding a bonus; the notifying means is a soliciting means, (col. 2:25-36 and col. 19:20-43).

33. **Examiner's Note:** Examiner has cited paragraphs and figures in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571)272-2460. The examiner can normally be reached on M-Th 9:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML
03/23/2009

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714